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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,159	05/23/2000	Kia Silverbrook	NPA004US	9179
24011	7590	01/25/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			DANG, DUY M	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,159

Applicant(s)

SILVERBROOK ET AL.

Examiner

Duy M Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-19 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed 9/14/04 has been entered and made of record.
2. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because claim 8 depends from a multiple dependent claim 7. See MPEP § 608.01(n). Accordingly, the claim 8 has not been further treated on the merits.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 10-15, and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. [GB2306669A. Art of record, IDS filed 3/2/01, paper #3].

Regarding claim 1, Wolff teaches a method for providing information in a document [see figure 5 and its corresponding text portion mentioned in page 16 line 18 to page 17 line 4] including:

establishing personalized user content preferences [i.e., the calendar book or CB generally shown at 10 in figure 5 and detailed at 20 in figure 1 (note that both calendar books 10 and 20 are the same according to page 16 line 21) comprising user's activities (i.e., call Abel, meeting with Baker and Charlie) and identity (i.e., barcode 13) corresponds to the so called "personalized user content preferences"];

selecting and formatting information corresponding to the content preferences [see step 505 of figure 2 and page 8 lines 13-23. Note that this step 505 selects and display CB page when identity of such a CB page and its corresponding user is checked to be valid. This CB page

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contains all prior entries (i.e., call Abel at 9:00, meeting with Baker at 10:00 and with Charlie at 10:30) as shown in figure 1. These entries included in CB shown in figure 1 correspond to the so called “formatted information corresponding to the content preferences”];

printing the formatted information in a document [see page 8 lines 21-23] with at least one user interactive element, the user interactive element being coincident with coded data [i.e., barcode 13 of CB 20 shown in figure 1 refers to the so called “interactive element”] which enables a user to indicate a response to associated information in the document by interacting with the element using a sensing device which is adapted to send the coded data and transmit response data to a computer system using the sensed coded data [see sensing device 91 of figures 5-6].

Regarding claim 2, Wolff further teaches future content preference [i.e., the meeting with Baker at 10:00 time segment of CB 20 in figure 1 for example. Note that the meeting with Baker takes place “call Abel” at 9:00 time segment. Thus, the meeting with Baker refers to future content preference. Likewise, the “Dinner” shown at 7:00 time segment also refers to future content preference].

Regarding claim 10, Wolff further teaches wherein the document includes coded data indicative of an identity of the document and of the at least one interactive element [see barcode 13 shown in figure 1], and wherein the method includes receiving, in the computer system, indicating data from the sensing device regarding the identity of the document [see sensing device 91 shown in figure 5 for sensing barcode 13 and transmitting these barcode information to computer system for identifying the CB] and a position of the sensing device relative to the document in order to identify and determine when the sensing device is used to interact with the

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element [see “motion associated with the act of writing” generated by the instrument 91 as mentioned in page 1 lines 1-3. Also refer to the “position sensor” shown at 210 in figure 6 and text portion mentioned on page 26 line 13 to page 27 line 15].

Regarding claim 11, Wolff further teaches receiving, in the computer system, movement data regarding movement of the sensing device relative to the document [see signature verification mentioned in page 6 lines 15-20 and system shown in figures 5-6. Note that signature represents the movement data regarding movement of the sensing device relative to the document].

Regarding claim 12, Wolff further teaches sensing device sensing its movement relative to the document using the coded data [see page 10 lines 14-16], and identifying the response in the computer system from the movement being at least partial within a zone associated with the interactive element [see page 10 lines 14-16].

Regarding claim 13, Wolff further teaches wherein the sensing device includes an identification code specific to a particular user [see page 10 lines 12-13] and the method includes monitoring use of the sensing device in the computer system [see page 10 line 14-25].

Regarding claim 14, Wolff further teaches printing the document [see page 8 lines 21-23].

Regarding claim 15, Wolff further teaches printing the formatted information a surface of a surface-defining structure [see barcode 13 printed on the CB 20 of figure 1] and printing the coded data on the surface [see barcode 13 printed on CB20 of figure 1].

Regarding claim 17, Wolff further teaches retaining a retrievable record of the printed document [see page 10 lines 6-13], the document being retrievable using the identity of data as

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contained in the coded data [see step 505 of figure 2. Note this step will display CB page when the identity of the sensing device and CB is checked to be valid].

Regarding claim 18, Wolff further teaches using a mixture of multicast and pointcast communications protocols (see figure 12 where communication link 93 refers to the so called “pointcast communication protocols” and Wide Area Networks through I/O interface 944 (page 23 line 16 and figure 12) refers to the so called “multicast communications protocols”]

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-7, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. [GB 2306669A. Art of record, IDS filed 3/2/01, paper #3].

Regarding claims 3-5 and 7, Wolff fails to teach the use of advertising material as the preferences. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use advertising material as preference. Applicant has not disclosed that using advertising material provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either information (shown in CB of figure 1) as preference taught by Wolff or the claimed advertising material. Therefore, it would have been obvious to one of ordinary skill in this art to use advertising material in Wolff to obtain the invention as specified in claims 3-5.

Regarding claim 6, Wolff fails to teach the use of content preference derived from demographic data of the user. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use user's demographic data as preference. Applicant has not disclosed that using user's demographic data as preference provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either information (shown in CB of figure 1) as content preference taught by Wolff or the claimed demographic data. Therefore, it would have been obvious to one of ordinary skill in this art to use demographic data in Wolff to obtain the invention as specified in claim 6.

Regarding claim 9, Wolff fails to teach rating for the article. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use rating the article. Applicant has not disclosed that using rating the article provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either information (shown in CB of figure 1) as taught by Wolff or the claimed rating the article. Therefore, it would have been obvious to one of ordinary skill in this art to use demographic data in Wolff to obtain the invention as specified in claim 9.

Regarding claim 19, Wolff fails to teach binding the pages. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use binding the pages. Applicant has not disclosed that using binding the page provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either information

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(shown in CB of figure 1) as taught by Wolff or the claimed binding the pages. Therefore, it would have been obvious to one of ordinary skill in this art to use binding the pages in Wolff to obtain the invention as specified in claim 19.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. [GB 2306669A. Art of record, IDS filed 3/2/01, paper #3] and in view of Dymetman et al. [Intelligent Paper. Art of record, IDS filed 3/2/01, paper #3].

Regarding claim 16, Wolff fails to teach wherein the coded data is substantially invisible to visible spectrum. However, such features are well known in the art as evidenced by the document to Dymetman et al.

Dymetman, in the same field of invention that of document manipulation, teaches that coded data is substantially invisible to the unaided human eye (see page 396 last five lines).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings as taught Dymetman in combination with Wolff as suggest by Dymetman (page 399 first full paragraph) in order to allow distributing blank paper which can be then printed or written above. In addition, by incorporating such features would reserve the authentication of the paper.

8. Applicant's arguments filed 9/14/04 have been fully considered but they are not persuasive.

In response to applicant's remarks with regard to objection to claim 7 under 37 CFR 1.75(c), it is noted that there is no such objection to claim 7. There is only objection to claim 8 under 37 CFR 1.75(c) as previously stated and repeated herein.

In response to applicant's argument (see paragraphs 3-4 of page 5) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein coded data is coincident with the visual information printed on the form) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's remarks (see paragraphs 5-8 of page 5) that Wolff's barcode does not correspond to a user interactive element which enables user to indicate a response. The examiner disagrees because Wolff does teach these features as shown in Figure 2 and its corresponding text portion described in line 6 of page 10 to line 17 of page 16. Specifically, steps 503, 503 and 505 for validating the user calendar book or CB by using bar code 13. The CB comprises a plurality of user interactive elements as shown in figure 1.

In response to applicant's remarks with regard to claim 12 (see last paragraph of page 6), the examiner disagrees because Wolff does teach that sensing device senses its movement relative to the document using the coded data (see page 11 lines 16-21).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Friday from 5:30AM to 2:00PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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1/23/05



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